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AUG 31 2005

Group 2700
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In re Application of
HARVEY, JOHN C., et al.
Application No. 08/487,411
Filed: June 7, 1995
For: **SIGNAL PROCESSING APPARATUS
AND METHODS**

DECISION
ON
PETITION

This is a decision in response to the Petition to the Director under 37 CFR § 1.181 filed March 7, 2005. The petition is treated under 37 CFR § 1.181(a)(1). (See MPEP § 1002.02(c)(3) and (4).)

The Petition is **GRANTED-IN-PART, DISMISSED-IN-PART and DENIED-IN-PART**.

Petitioner requests that "the Director of Patents and Trademarks ('Director') exercise his supervisory authority by (1) exercising authority over the Examiner responsible for this application with respect to a Notice of Suspension mailed January 6, 2005, and (2) exercising authority over Group Director responsible for supervising the Examiner assigned to the present application and other examiners in Technology Center 2600 assigned to examine other applications related to the present applicant having an identical disclosure to this application."

Petitioner requests two forms of relief in seven total parts:

"First Applicants respectfully ask the Director to require the Examiner to rescind the Notices of Suspension..."

The second request includes six sub-parts as follows:

1. Impose a schedule for the prompt examination of this application...
2. Declare that this application and Related Applications are "special, and treat them as such.
3. Assign new and objective primary Examiners to this and the Related Applications.
4. Establish a committee to supervise the examination of this and the Related Applications to ensure that the examination is conducted in accordance with an accelerated schedule.
5. Inform Applicant's whether its applications are on the internal PTO sensitive Application Warning System (SAWS) list.
6. Identify any other special review procedures or lists that this and other related applications may be subject to other than "normal" patent applications are not subject to.

Note: The petition requests relief in this application and several other related applications. In accordance with 37 CFR § 1.4 matters directed to the related applications will be handled in the respective applications.

BACKGROUND

This application was filed June 7, 1995 along with approximately 328 related applications with identical disclosure filed between March and June 1995.

- The application was amended three times prior to a first Office action being mailed on February 21, 1997.
- An amendment was filed August 12, 1997.
- A non-final Office action was mailed May 26, 1998.
- Four more amendments were filed.
- On June 19, 2002 an Administrative Requirement was imposed requiring applicant to:
 - (1) File terminal disclaimers in each of the relate co-pending applications terminally disclaiming each of the other co-pending applications;
 - (2) Provide an affidavit attesting to the fact that all claims in the co-pending applications have been reviewed by applicant and that no conflicting claims exists between the applications; or
 - (3) Resolve all conflicts between claims in the identified co-pending applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the identified co-pending applications.

The requirement was deferred until the file is in condition for allowance.

- On July 8, 2002 an amendment was filed.
- On September 5, 2002 a non-final Office action was mailed.
- On March 5, 2003 an amendment was filed.
- On January 6, 2005 the application was suspended for a period of six months.

On pages 5 through 25 Petitioner describes some of the prosecution history of this and the related applications.

DISCUSSION/DECISION

Rescinding Notice of Suspension

On page 3 of the petition, petitioner states that “(t)he PTO has purposefully delayed prosecution of this application...at every turn, in direct violation of the Manual of Patenting Examining Procedure’s (‘M.P.E.P’) mandate for examination under section 701. In response to each delay, Applicants diligently answered and complied with, or strenuously objected to when deemed necessary, each and every request and requirement from the PTO. ...Applicants have expended an extraordinary amount of resources – including \$2 million dollars in PTO fees alone.” Petitioner continues to argue, stating that the Office “is solely responsible for the delay in examination” and that the “PTO’s own unwillingness to comply with its own rules and procedure led to this abhorrent situation.” Then again on page 10 of the petition, petitioner states (in connection with the agreement to consolidate some of the pending files) “(t)his process cost PMC more than \$500,000 in new filing and other PTO fees, and more than \$1 million in attorney’s fees.

Petitioner has not established how payment of fees contributes to Office delay in prosecution of the application. The Office did not compel Applicant to file 329 applications and the associated filing fees therefor. In contrast to Petitioner’s contention, it is noted that applicant has paid approximately \$4680 in extension of time fees for the instant application resulting in significant delay by applicant.

On page 28, petitioner argues that “the M.P.E.P. permits Office-initiated suspensions in only two instances: (1) when the PTO is awaiting a new reference under (Form Paragraph) 7.52 and (2) once claims are deemed allowable, when possible interference is detected under (Form Paragraph) 7.53. Neither situation applies here.” While it is agreed that the two instances do not apply in this situation; the two instances of suspensions are merely two of the common examples of Office initiated suspension of prosecution. In accordance with 37 CFR § 1.103(e), “(t)he Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.” MPEP 709 II states in part, “...Once a suspension of action has been initiated, it should be terminated immediately once the reason for initiating the suspension no longer exists... If, in an extraordinary circumstance, a second or subsequent suspension is necessary, the examiner must obtain the TC director’s approval...” A review of the record indicates that the suspension of January 6, 2005 is signed by the TC director in accordance with the procedure as set forth above. Contrary to petitioner’s arguments, the outcome of the related reexamination proceedings have a direct bearing on the prosecution of this and the related applications under suspension. Petitioner argues that the claims of the reexamination proceedings are different than the instant claims. However, the specifications are the same and the claims so closely related as to warrant disposition of the reexamination proceeding prior to continuing the prosecution in the instant case. The related pending applications that currently are under appeal have prosecution that is closely related to this and the other suspended files. The decision soon to be rendered by the Board of Patent Appeals and Interferences will have material impact in determining future action by the Office as whether to allow or reject certain claims. A decision by the Board is

necessary as a form of guidance to steer prosecution of the remaining cases in a manner commensurate with the Board's decision. Having this information prior to continuing prosecution of the remaining cases will afford both applicant and the Office information vital in order to focus prosecution, undoubtedly significant prosecution time and resources for both parties.

Consequently, the petition to rescind the suspension is **DENIED**.

Impose a Schedule for Examination

In view of the above discussion concerning the suspension, the request to impose a schedule on the examiner for prompt examination of this application is a Moot issue and is **DISMISSED**.

Notwithstanding this decision, the following points are noted. On page 32 of the petition, petitioner states that "the Director should impose an aggressive schedule on the Examiner of this application." All applications filed in the PTO have an aggressive schedule for examination. MPEP § 708 states in part that "(e)ach examiner will give priority to that application in his or her docket, whether amended or new, which has the oldest effective U.S. filing date. Except as rare circumstances may justify Technology Center Directors in granting individual exceptions, this basic policy applies to all applications." (Emphasis supplied.) The situation in this case and in the related pending cases as pointed out by petitioner and addressed herein clearly is a rare justifiable circumstance warranting exception by the Technology Center Director to suspend the instant application. Since the application is in a suspended status, an "aggressive" schedule cannot be contemplated at this time.

Application Granted "Special" Status

Petitioner argues that the instant application should be granted special status. Petitioner urges that "(t)he present application was filed June 6, 1995 and claims priority under 35 USC § 120 to an application filed on September 11, 1987. Section 708.01(i) of the MPEP designates such an application as a 'special case'." Petitioner is correct in that the pendency of the application is in excess of five years and therefore must be considered "special". However, a petition to effect such a status is unnecessary as the MPEP clearly indicates that an application pending for such a period is special in nature. Accordingly, the request to afford special status is **DISMISSED**. The fact that the application has been pending in excess of five years does not remove the suspended status. The application remains suspended for good and sufficient cause as outlined above. Subsequent to the suspension being lifted, the application will be taken out of turn and afforded expedited examination.

Assign New and Objective Primary Examiner

Petitioner requests that the application be assigned to a new and objective primary examiner. On pages 16 through 22 of the petition, petitioner argues that examiner Luther's examination of the application is improper. Upon filing, an application is assigned to an examiner based upon technology and expertise in a particular art area depending on factors such as workload and available resources available to handle such workload. The commissioner (Director) has the authority to cause an examination of the application. 35 USC § 131. The Director delegates this

authority to a primary examiner to act on behalf of the Director in all “normal” aspects of the examination processes. Applicant has no right to pick and choose the examiner assigned to a particular application as this would cause undue burden upon the agency. Applicant has two avenues of relief when disagreeing with the examiner. 1.) The remedy for improper rejection is appeal to the BPAI (37 CFR 1.191(a)) and 2.) The remedy for other improper examiner actions is petition (37 CFR 1.181(a)). These are adequate remedies to address petitioner’s concerns related to Examiner Luther’s examination. Notwithstanding the above, Examiner Luther is no longer assigned to this application. Consequently, the request that the application be assigned to a new and objective examiner is moot and therefore **DISMISSED**.

Establish a Committee to Supervise the Examination

Petitioner requests that a committee be established to supervise the examination of this application. Examination by committee is not the “normal” practice of examination by the agency. Primary examiners handle the prosecution of applications or oversee and are responsible for the prosecution by examiners that do not have signatory authority. The request is **DENIED**.

Inform Applicant if Application is on Special Lists

The petition requests that the Office identify any special review procedures or warning lists that this application may be subject to that other “normal” patent applications are not subject to. The request is **GRANTED**. The application is not on any special list. However, the fact that applicant chose to file 329 related applications with identical disclosure requires special prosecution review procedures that would not otherwise be required in a “normal” application. The interrelationship between so many applications with identical disclosure requires special attention particularly when considering potential double patenting issues.

SUMMARY

The Petition to rescind the Notice of Suspension is **DENIED**.

The request to impose a schedule for prompt examination of the application is **DISMISSED**.

The request to declare this application “special” is **DISMISSED**.

The request to assign the application to a new primary examiner is **DISMISSED**.

The request to establish a committee to supervise the examination of this application is **DENIED**.

The request to identify any special review procedures or lists that this application is subject to is **GRANTED**.

CONCLUSION

It would be inappropriate to rescind the suspension until such a time as the prosecution in the related applications and proceedings are concluded. As such, an aggressive schedule for examination is not possible at this time. This application is considered "special" in accordance with MPEP 708. The application is no longer assigned to Examiner Luther. Examination by committee is not a practical way to examine applications files within this agency. This application is not on any special lists. It may, however, be subject to special review procedures as set forth above.

Any request for reconsideration of this decision must be filed within **TWO MONTHS** from the date of this decision. This time period is not extendable. Petitioner may also wish to petition this decision in accordance with 37 CFR § 1.181(a)(3).



Andrew Faile
Director Technology Center 2600